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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,349	03/26/2004	Andreas Steinert	Mo-7105D/BOR-4	1565
34947	7590	03/01/2006	EXAMINER	
LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112			ANTHONY, JOSEPH DAVID	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 03/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,349

Applicant(s)

STEINERT ET AL.

Examiner

Joseph D. Anthony

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/191,382.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin U.S. Patent Number 4,720,566 or Hester, Jr. U.S. Patent Number 4,009,175.

Martin U.S. Patent Number 4,720,566 teaches method and composition for inhibiting acrylonitrile polymerization. Applicant's claims are deemed to be anticipated over the composition which comprises: 1) N,N-diethylhydroxylamine (reads on a species within applicant's formula (I)), 2) dimethylformamide (reads on a species within applicant's formula (III)), 3) naphtha, and 4) phenylenediamine, as set forth in column 6, line 63 to column 7, line 8.

Hester, Jr. U.S. Patent Number 4,009,175 teaches certain benzodizepines and methods of making thereof. Applicant's claims are deemed to be anticipated over the reaction compositions that comprise in part: 1) N,N-dimethylhydroxylamine or N,N-diisopropylhydroxylamine (reads on species within applicant's formula (I)), 2) dry dimethylformamide (reads on a species within applicant's formula (III)), and 3) mineral oil suspension of sodium hydrate, as set forth in Examples 15 and 25.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Small U.S. Patent Number 5,981,454

Small U.S. Patent Number 5,981,454 teaches post cleaning treatment compositions comprising: 1) a monofunctional, difunctional or trifunctional organic acid, and 2) a buffering amount of amine containing compound such as hydroxylamine which seems to be preferred, see the abstract and examples. A specifically disclosed monobasic organic acid is formic acid (reads on a species within applicant's formula (III)), and a specifically disclosed dibasic organic acid is malonic acid (reads on a species within applicant's formula (II)), see Table II. Applicant's claims are deemed to be anticipated when an hydroxylamine buffering agent is admixed with a monofunctional acid, such a formic acid, or is admixed with a difunctional organic acid such as malonic acid since such would be at once envisaged from the directly disclosure of the patent to do just that. In the alternative, applicant's invention can be said to "differ" from Small in that there is not a direct teaching (i.e. by way of an example) to an actual admixture of a

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hydroxylamine with a monofunctional acid, such a formic acid, or an actual admixture of a hydroxylamine with a difunctional organic acid such as malonic acid. It would have been obvious to one having ordinary skill in the art to use the direct disclosure of Small as strong motivation to actually make compositions that are mixtures of hydroxylamine and a monofunctional acid, such a formic acid, or an a admixture of a hydroxylamine with a difunctional organic acid such as malonic acid.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Link et al. U.S. Patent Number 5,985,018 or WO 00/11090, both references individually in view of Derwent English Language abstract ACC No.: 1968-43058Q/ 196800 of DE 1519103.

Link et al. U.S. Patent Number 5,985,018 teaches anti-skinning agents for oxidatively drying coating compositions. The reference teaches compounds of formula (II) that read on applicant's claimed organic compounds of formula (II), see column 2, lines 44-55, column 4, lines 1-18 and claim 7. The reference differs from applicant's claimed invention in that the reference has no direct teaching to admixing applicant's claimed compound of formulas (I) with the disclosed compounds according to formula (II) to form an anti-skinning composition.

WO 00/11090 teaches anti-skinning agents for coating compositions wherein the compounds according to formula (I) are deemed to read on applicant's organic compounds of formula (II), see the abstract, page 5, lines 11-19 and page 7, lines 28-30. The reference differs from applicant's claimed

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invention in that the reference has no direct teaching to admixing applicant's claimed compounds of formula (I) with the WO's disclosed compounds according to formula (I), reads on applicant's formula (II), to form an anti-skinning composition. The concentration of the said anti-skinning agent when used in a subsequent composition is from 0.1-5% by weight of the composition, see page 7, lines 28-30.

Derwent English Language abstract ACC No.: 1968-43058Q/ 196800 of DE 1519103 teaches that N,N-dialkylated hydroxylamine are known anti-skinning agents in oil and alkyd resin lacuers, see the abstract. These N,N-dialkylated hydroxylamine are deemed to read on applicant's compounds of formula (I). The concentration of the said anti-skinning agent when used in a subsequent composition is from 0.01-2% by weight of the composition.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Derwent English Language abstract ACC No.: 1968-43058Q/ 196800 of DE 1519103 to the teaching that N,N-dialkylated hydroxylamine are known anti-skinning agents in oil and alkyd resin lacuers, as motivation to actually incorporate said anti-skinning agents into the anti-skinning compositions, as disclosed by the primary references, which contain anti-skinning agents according to applicant's formula (II) for the benefits such admixtures would cause. Such is motivated by the courts which have constantly declared that to employ two or more materials in combination for the same purpose that they are taught as being individually useful is not patentable outside a showing of superior

and unexpected results, see *In re Kerhoven*, 205 USPQ 1069 (1980).

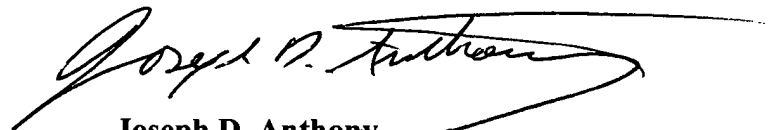
Furthermore, both primary reference to Link et al and WO directly teach the use of admixtures of anti-skinning agents.

Prior-Art Cited But Not Applied

6. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

2/25/06